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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,199	07/30/2003	Juergen Wulf	GK-OEH-163 / 500814.20065	2020
7590	03/08/2006		EXAMINER	
Gerald H. Kiel, Esq. REED SMITH LLP 599 Lexington Avenue New York, NY 10022-7650			LEV KOVICH, NATALIA A	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 03/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,199

Applicant(s)

WULF ET AL.

Examiner

Natalia Levkovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and remarks filed on 12/13/2005 have been acknowledged by the Examiner and entered.

Claim Rejections - 35 USC § 112

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
3. The 35 U.S.C. §112 rejection of claim 22 is withdrawn in view of the latest amendments.

Claim Rejections - 35 USC § 102

4. Claims 1-5, 8-13 and 19-20 are rejected under 35 U.S.C. 102(e) as anticipated by Giebeler et al. (US 20020176801).

See the appropriate paragraphs of the prior office Action.

Claim Rejections - 35 USC § 103

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giebeler in view of Marouiss et al. (US 20010048899).

See the appropriate paragraphs of the prior office Action.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giebeler in view of Schick (US 20030230521).

See the appropriate paragraphs of the prior office Action.

7. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giebeler in view of Sekiya et al. (US 5,828,498) and further in view of Gerdt (US 6,731,845).

See the appropriate paragraphs of the prior office Action.

8. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giebeler in view of Sekiya, in view of Gerdt and further in view of Phillips et al. (US 6584052).

Response to Arguments

9. Applicant's arguments filed on 12/13/2005 have been fully considered but they are not persuasive.

Applicant argues that 'Giebeler fails to teach or suggest a CCD camera being oriented by the optical system to a large-area rectangular region...' Examiner notes that, with respect to the shape, Giebeler discloses, as was previously discussed in the prior Office Action, the use of 'a suitable CCD (rectangular or square...)'. As to the size of the area, no clear and definite criteria in this regard were set forth in the claims.

Applicant argues that 'Giebeler does not disclose a light source with optics to direct light to the sample holder'. Examiner suggests that the above-mentioned functionality is not a part of the claimed invention.

Applicant argues that 'the Giebeler approach in contrast to the claimed invention is that Giebeler teaches to have, at first, the ignition event and then a movement to the analysis module.' Examiner notes that the above-mentioned functionality is not a part of the claimed invention.

Applicant argues that 'the light emission process according to the invention is observed completely over time (without any gaps of measurements as taught by Giebeler) and completely independent of the start positions, progress velocity, and repetition rate etc. of ignition events (dispensation of reactants)'. Examiner submits that the above-mentioned functionality is not a part of the claimed invention.

Applicant argues that 'Giebeler does not provide a dispensing unit having at least one linear dispensing comb having a symmetric treelike structure'. Examiner notes that 'treelike' in common understanding is a branching structure having vertical central axial symmetry. As discussed previously, the dispense system of Giebeler comprises a modular dispensing comb having a symmetric structure relative to imaginary vertical axis, illustrated in Figures 6-7. Piston support plate 638 and piston retaining plate 640 form the 'branches'.

Applicant argues that 'Giebeler does not teach that the two or more rows or columns are used for different reactants to add them one after the other to the samples of the microplate. Thus, Giebeler does not teach or suggest that the elapsed time for the

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luminescence is measurable simultaneous with the ongoing dispensing in each of the columns of wells of the microplate in which dispensing is carried out successively.

Examiner notes that the underlined functionality is not a part of the claimed invention.

Applicant argues that 'Giebeler does not teach or suggest imaging an entire rectangular area', 'at best the whole microplate', since 'Giebeler utilizes intensive light sources (flash lamps, arc lamps or a laser)' and since a 'defined number of optical fibers and optical heads are applied to couple each single sample well to one detector element'. Examiner notes that imaging 'the whole microplate' is not clearly and distinctly claimed, as well as the elements underlined above.

Applicant argues that, there is no need for pumps according to the invention of Giebeler 'because the fluid is transported from a reservoir to the dispenser comb and ejected'. Examiner insists that pumps are necessary for transporting 'the fluid from a reservoir to the dispenser comb'.

Applicant argues that 'Marouiss fails to cure all the deficiencies of Giebeler'. Examiner agrees and notes that, as was previously discussed in the prior Office Action, Marouiss teaches controllable valves for dispensing units which Giebeler does not specifically teach. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed controllable valves with the dispensing units in the apparatus of Giebeler, in order to monitor the fluid flow.

Applicant argues that 'Schick discloses a waste trough in connection with a wash and/or equilibration buffer bag due to the use of tubing apparatus that is provided for sucking fluids. That is different from the intention of the invention to have the waste

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trough only if applying different fluids and to eject a first fluid out of the pipes and nozzles downstream after the valve switched for applying a second fluid'. Examiner would like to draw Applicant's attention to the fact that the above functionality is not a part of the claimed invention.


Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700